

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK R. BUNKER

Appeal 2007-0844
Application 10/790,473
Technology Center 2600

Decided: June 6, 2007

Before JAMES D. THOMAS, JOSEPH L. DIXON, and JOHN A. JEFFERY,
Administrative Patent Judges.

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. §§ 6(b) and 134 from the Examiner's final rejection of claims 1-24.

We AFFIRM.

BACKGROUND

Appellant's invention relates to a system for disabling custom calling features for calls originating from a restricted area. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A system for restricting telephone calls that originate from a facility, the system comprising:

at least one facility resident telephone configured to originate and present a call signal;

a switching office; and

a destination telephone, wherein the at least one facility resident telephone, the switching office, and the destination telephone are electrically serially coupled such that a call signal originating at the at least one facility resident telephone is routed to the destination telephone via the switching office, and wherein the switching office disables at least one custom calling feature corresponding to the call signal upon determining the call signal as originating from the at least one facility resident telephone.

PRIOR ART

The prior art reference of record relied upon by the Examiner in rejecting the appealed claims is:

REJECTIONS

Claims 1-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gallant.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellant regarding the above-noted rejection, we make reference to the Examiner's Answer (mailed Jul. 14, 2006) for the reasoning in support of the rejections, and to Appellant's Brief (filed Mar. 27, 2006) and Reply Brief (filed Aug. 18, 2006) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellant's Specification and claims, to the applied prior art references, and to the respective positions articulated by Appellant and the Examiner. As a consequence of our review, we make the determinations that follow.

35 U.S.C. § 103

At the outset, we note that to reach a proper conclusion under § 103, the Examiner, as finder of fact, must step backward in time and into the mind of a person of ordinary skill in the art at a time when the invention was unknown, and just before it was made. In light of all the evidence, we review the specific factual determinations of the Examiner to ascertain whether the Examiner has convincingly established that the claimed invention as a whole would have been obvious at the time of the invention to

a person of ordinary skill in the art. When claim elements are found in more than one prior art reference, the fact finder must determine “whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims.” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1337 (Fed. Cir. 2006). With respect to the role of the Examiner as finder of fact, the Court of Appeals for the Federal Circuit has stated: “the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The Court of Appeals for the Federal Circuit has also noted: “[w]hat the prior art teaches, whether it teaches away from the claimed invention, and whether it motivates a combination of teachings from different references are questions of fact.” *In re Fulton*, 391 F.3d 1195, 1199-1200, 73 USPQ2d 1141, 1144 (Fed. Cir. 2004) (internal citations omitted). In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l v.*

Teleflex Inc., 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. “[T]he name of the game is the claim.” *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998).

Therefore, we look to the limitations as recited and disputed in independent claim 1. From our review of the Examiner’s rejection, we find that the Examiner has set forth a proper initial showing, with respect to independent claim 1, to shift the burden to Appellant. We note that the Examiner maintains that Gallant teaches all the limitations but for the serial communication.

Appellant argues the independent claim 1 differs from Gallant in that independent claim 1 recites that a custom calling feature corresponding to a call from a party A to party B is disabled as a result of the call having originated from party A whereas in Gallant the custom calling feature corresponding to a call from party A to party B is disabled based upon the profile information associated with party B (Br. 9 and Reply Br. 2-9).

The Examiner disputes Appellant’s contention and identifies paragraph [0058] as verifying the privileges of the first user to reach the second user and performing any call handling features provisioned for the first and second users (Answer 4). Here, we agree with the Examiner that Gallant is not limited to merely using the profile information of the second user/party B. Additionally, we find that paragraph [0008] teaches that an administrator may perform call blocking and place outgoing call restrictions on individual users. Additionally, the administrator may make restrictions on out-going calls to certain international phone number ranges for different individual

users. We find this teaching to show that a restriction may be based solely upon the originating party and to be suggestive of the ability of the system to perform similar restrictions on other custom calling features based upon the individual user which originates the call. We additionally find that paragraphs [0051] and [0066] buttress our finding that Gallant does make determinations based upon the location of the originator of the call and furthermore that it would have been obvious to one skilled in the art at the time of the invention to have used the location of the originator of the call to disable certain custom calling features based upon the location or identity of the user placing the call.

From our review of the teachings of Gallant, we find that Gallant teaches both the use of party A and/or party B as a determining factor to disable calls and calling features. With that as a baseline, we find that it would have been obvious to one skilled in the art at the time of the invention to have used the origin of the call as a basis for disabling any or all custom calling features by the administrator, proxy server, or location server in the various network structures as taught by Gallant. Therefore we cannot agree with Appellant that Gallant does not teach or fairly suggest the limitation of claim 1 that “the switching office disables at least one custom calling feature corresponding to the call signal upon determining the call signal as originating from the at least one facility resident telephone.” Therefore, Appellant's argument is not persuasive, and we will sustain the rejection of independent claim 1 and dependent claims 2-11 which Appellant has not provided separate argument for patentability.

With respect to independent claim 12, Appellant relies upon the arguments advanced with respect to independent claim 1 which we did not

find persuasive above. Therefore, we will sustain the rejection of independent claim 12 and dependent claims 13-22 which Appellant has not provided separate argument for patentability.

With respect to independent claims 23 and 24, Appellant argues that Gallant teaches the use of profile information associated with party B as the basis for disabling a custom calling feature and Appellant relies upon the reasons advanced with respect to independent claim 1 (Br. 13-14) which we did not find persuasive above. Therefore, we will sustain the rejection of independent claims 23 and 24.

CONCLUSION

To summarize, we have sustained the rejection of claims 1-24 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

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AFFIRMED

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